

### Remarks

Claims 29-33, 35, and 37-42 were rejected in the Office Action. Claims 1-28, 34, 36, 43 and 44 were previously cancelled without prejudice.

With this paper, Claims 29-33, 35, 37 and 38 have been amended. The amendments find support throughout the originally filed specification, see, for example, paragraphs [0020], [0021], [0022], [0026], [0028], [0035], and Abstract of the published application, which is U.S. Publication No. 2004/0187369. Applicants have also amended the specification to correct a typographical error. No new matter has been introduced with said amendments. Applicants respectfully request entry and acceptance of the amendments set forth herein.

New claims 45 and 46 have been added, find support in the originally filed specification and do not introduce new matter. Their entry and acceptance is respectfully requested.

In the Office Action, the Examiner rejected Claims 29-33, 37-40 and 42 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,294,469 (hereinafter, "Errichiello") in view of U.S. Patent No. 4, 460,637 (hereinafter, "Miyamoto") and U.S. Patent No. 4,828,421 (hereinafter, "Arakaki"). The Examiner states that Errichiello teaches many of the claimed features except the Examiner admits that Errichiello does not teach the following:

- "the indentation in the surface of the member has a 'depth at least as great as the thickness of said image sheet,'" or
- "that the printed page is formed from ink;" or
- "that there is a transparent laminate sheet overlaying the printed image and cut according to contours of the printed page;" or
- "that there is a ink receptive coating on the image sheet."

Applicants generally agree with the Examiner that Errichiello does not teach or suggest any of the above listed features. In addition, Applicants respectfully submit that Errichiello does not teach or suggest a sheet or film of flexible material that is about 4.0 mils to about 12.0 mils.

Furthermore, Errichiello does not teach or suggest that a transparent laminate sheet is bonded to the printed image. In addition, Errichiello does not teach or suggest that the image film overlaid with a laminate sheet is precisely cut according to contours of the printed image or that the image film is permanently welded onto the member. Moreover, Errichiello does not teach or suggest that the planar indentation and depth is so to recess of the image sheet in the member.

Applicants have amended the claims to further describe the claimed invention, which is not patentable over Errichiello in view of Miyamoto and Arakaki. For example, Errichiello specifically teaches a book binder having a cavity cut into the plastic and into which a separately molded insert is press fitted or snap fitted. The inserts are molded like the book binder is. In addition, it is stated that “thin ribs 38 on the longitudinal edges of the spine insert” (Col. 4, ll. 5-7) and “thin, narrow, raised rib” are provided around front face insert panels or cavities (Col. 4, ll. 36-39). Such a configuration is not essential to nor required by Applicants’ claimed invention because Applicants teach a very different invention which is film bonded to a member, the member having an indentation for receiving the film, which is not a cavity. A cavity and an indentation are descriptively different. A cavity is generally described as a sizeable hole. On the other hand, the image film of Applicants’ invention is clearly stated to be about 4.0 mils to about 12.0 mils and would not be considered a sizeable hole by one skilled in the relevant art. The Examiner can interpret a claim term only as reasonably allowed and such interpretation cannot be inconsistent with the specification. [MPEP 2111] Errichiello also does not teach or describe that the insert is a thin film of about 4.0 mils to about 12.0 mils. There is no suggestion or teaching by Errichiello that such a thin film was achieved or capable of being achieved, especially when the insert is expressly stated to be pressed fit or snap fitted into the cavity. It certainly is not obvious by the reference itself and there is no secondary evidence of any kind showing otherwise. It is also pointed out that Errichiello clearly shows and states that the spine insert is made of a planar medium strip 80 with longitudinal, right angular lips 82, 84, which clearly teaches away from and prevents this insert from bonding along its entirety to the cavity. Furthermore, it would not be obvious to one skilled in the art based on the teachings of Errichiello to know how to be able to mold an insert at “any depth,” let alone a depth of about 4.0 mils to about 12.0 mils. The Examiner has not provided any such evidence as to how this

could be done, certainly Errichiello provides no such showing, and a mere statement stating that it would have been obvious is not sufficient for a showing of obviousness. Applicants also respectfully point out that, in agreement with the Examiner, Errichiello does not teach or suggest a thin laminate sheet directly bonded to and overlaying the printed image.

*In Re Ravi Vaidyanathan* (2009-1404, Fed. Cir. 2010) held that an Examiner is responsible for explicitly setting forth factual findings of obviousness. It was stated that there must be a persuasive explanation with evidentiary support as to how a person would select and apply the teaching(s) of each reference as well as a thorough reasoning with support as to why a person of ordinary skill would select and combine various features from different references to arrive at the stated conclusion. It was further held that if such support could not be found in the prior art, then the Examiner may “choose instead to provide an affidavit detailing the examiner’s own personal knowledge (as a person approximating one of ordinary skill in the art) of the technology in question.” Applicants respectfully submit that neither the factual findings for obviousness nor an affidavit have been provided and, thus, the burden for providing a *prima facie* showing of obviousness has not been met.

Errichiello was combined with Miyamoto and Arakaki. However, none of these references overcome the lack of teachings in Errichiello. For example, Miyamoto simply teaches an ink jet recording sheet having one or more “receptive layers” with tiny pores. Miyamoto further teaches that when pigment particles are included in the ink-receptive layer, it requires “an adhesive to hold them in place” (Col. 6, ll. 64-68). Miyamoto was not found to teach or suggest at least any of the following that are also missing in Errichiello:

- “the indentation in the surface of the member has a ‘depth at least as great as the thickness of said image sheet,’”; or
- “that there is a transparent laminate sheet overlaying the printed image and cut according to contours of the printed page.”

Arakaki is found to teach an album cover that has a very large recess 16 in which smaller items such as “a photograph, a certificate, a diploma or other memorabilia” are placed (Col. 2, ll. 37-42). Such substances are either: (a) permanently placed in the recess “by a hardened polymer

resin” that “is poured into the recessed portion 16 and is allowed to harden” (Col. 2, ll. 27-31); or (b) have “a transparent cover 70 covering recessed portion 20,” in which the transparent cover is “detachably affixed to the interior surface by a plurality of fasteners.” (Col. 2, ll. 42-45). Like Errichiello, Arakaki does not teach or suggest a sheet or film of flexible material that is about 4.0 mils to about 12.0 mils. Furthermore, like Errichiello and Miyamoto, Arakaki does not teach or suggest that a transparent laminate sheet is bonded to the printed image. In addition, like Errichiello and Miyamoto, Arakaki does not teach or suggest that the image film overlayed with a laminate sheet is precisely cut according to contours of the printed image. Moreover, like Errichiello and Miyamoto, Arakaki does not teach or suggest that the planar indentation and depth is so to recess of the image sheet in the member.

In view of the above findings, neither Errichiello, Miyamoto, or Arakaki, alone or in combination, teach or suggest each and every element of the claimed invention, which is required for a showing of obviousness. Applicants respectfully request the claims rejections be removed and the claims be allowed to proceed to allowance.

### **Conclusion**

In light of the amendment and remarks presented with this paper, Applicants respectfully submit that the claims provided in the Listing of Claims beginning on page 3 of this paper are in allowable form. Accordingly, Applicants respectfully request the application proceed to allowance.

This paper serves as a petition for an extension of time for any needed extension, such as that pursuant to 37 C.F.R. § 1.136. Applicants respectfully request that the Commissioner grant such a petition and authorize the Commissioner to charge any extension fee not paid to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney No. 125447-1005. Please credit any overpayment to the same Deposit Account.

Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214-999-4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application and/or place the application in condition for allowance.

**Please direct all correspondence to the practitioner listed below at Customer No. 32914.**

Respectfully submitted,

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